APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
THOMASSON, MEAGAN J

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/965,605	PAU ET AL.
	Examiner	Art Unit	.
	Meagan Thomasson	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2006*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail. Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

In response to the amendment filed January 12, 2006, claims 1-4 and 6-23 are

pending. Examiner acknowledges amendments made to claims 1, 14, 17, 19, and 20,

and the addition of new claims 21-23.

Claim Rejections - 35 USC § 103

1.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

2.   Claims 1-4, 6-9, 12, 14-17, and 19-23 are rejected under 35 U.S.C. 103(a) as

being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US

Pat 5,788,573).

Regarding claim 1, O'Halloran teaches a gaming machine with display means

(Element 20) and control means (Element 32) being disposed to play an underlying

game with underlying prizes associated with the underlying game (See Figure 2)

wherein on the occurrence of a predefined event or triggering event (See Col 1:49) the

player is enters a second game in which a common game type with two or more game

choices is provided (See Col 1:50-51 & Col 2:12-24). O'halloran further discloses the

second game in which the player selects a card from a row of cards and where further

the chance of the player selecting a card that would yield a winning out come is

inversely proportional to the number of card per the row selected thus indicating a

random assignment of the winning card as so claimed (See Col 2:16-24 & Figures 4 and 5),

O'Halloran further teaches allowing the player to choose only one prize set as so claimed in the players selection of the eight of spades second set in Figure 5 for example. The previous selection made immediately following the start off the bonus round results in the selection of one prize set and a selection of a non-winning outcomes or equivalently elements (*Eight of spades shown in figure 5* & Col 3:66-4:3) that in turn ends the bonus game, wherein as understood the bonus game only continues upon a win in the bonus game (Col 3:62-65).

The claimed "total theoretical return to the player is the same regardless of the prize the player chooses" is an inherent feature of gaming devices in that a fixed total theoretical return is required by gaming law or gaming regulations as per the applicants arguments on page 6 of paper 11.

O'Halloran is silent on including bonus game prizes that are independent of the prize awarded in the underlying game and the displaying of at least two winning outcomes within at least one of the prize sets.

Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set size of multiple winning outcomes and a non-winning outcome that further spin randomly before stopping on a segment so as to define a prize won, which is independent of any prize awarded in the underlying game and upon

defining the prize won the several other possible prize outcomes are displayed to the user (See Figures 4 & 6).

It would have been obvious to one of ordinary skill in the art at the time of invention to included prizes that are independent of the prize awarded in the underlying game of O'Halloran and the displaying at least two winning outcomes within at least one of the prize sets thereof, in light of the teachings of Baerlocher et al, in order to avoid player perception of being penalized for getting a bonus event on a small win in the underlying game or alternatively give the player the perception of a greater amount of total prize possibilities in a similar fashion to the spinning of the reels of a traditional slot machine.

Regarding Claims 2-4 and in addition to the above stated. O'Halloran teaches one winning outcome or the Joker card being presented per row or prize set and at least one non-winning outcome being presented per row or prize set (See Figure 5). This corresponds to one or more prize outcomes, which are identical in the same prize set or in a different prize set (See the middle and bottom rows of cards in figure 5) where in the identical prize outcomes are the non-winning outcomes represented via the non-Joker type playing cards.

Regarding claim 17 and in addition to the above stated. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set

size and spin randomly before stopping on a segment that defines a prize won (See

Figures 4 & 6).

Regarding claims 6-8 and in addition to the above stated. O'Halloran teaches

the use of a combination of symbols appearing on the win lines of a spinning reel game

of chance for the purposes of triggering a game feature (See Col 3:15-21). This

corresponds to the occurrence of a special combination in claim 6 as presented, the

triggering of a game feature (triggering event as so claimed) at random in claim 7 as

presented where in the random triggering is due to the random alignment of the trigger

event or winning combination on a reel game, and a spinning reel game as presented in

claim 8 (See Figure 2).

Regarding claim 12 and in addition to the above stated. O'Halloran teaches the

presentation of each prize set distinctly as each prize set as so claimed is presented

herein as a row of cards (See Figures 4 and 5).

Regarding claims 9, and 14-16 and in addition to the above stated. O'Halloran

teaches the presentation of player selectable prize sets that includes: winning and non-

winning outcomes and identical prize outcomes located between sets and located with

in the same prize set but is silent on the use of use of segments on a spinning wheel to

define the prize outcome. Baerlocher et al discloses a bonus game for a spinning reel

game of chance containing a bonus round that incorporates multiple spinning wheels or

simulations thereof that spin randomly before stopping on a segment that defines a

prize outcome won by the player (See Figure 6). It would have been obvious to have

incorporated the multiple spinning wheels or simulations thereof that spin randomly

before stopping on a segment that defines a prize outcome as taught by Baerlocher et

al in the invention of O'Halloran in order to suit the theme of the bonus game being

played or adapt an existing bonus game to a machine with a wheel theme.

Regarding claims 14-16, and 19 and in addition to the above stated, O'Halloran

teaches the presentation of player selectable prize sets that include: winning and non-

winning outcomes and identical prize outcomes located between sets and location

within the same prize set but is silent on the inclusion of multiple different wheels,

wherein the display means displays the two or more different wheels simultaneously

and wherein once a wheel is selected by the player, said wheel is enlarges relative to

any non-selected wheels. However in addition to the above, Baerlocher teaches the

enlargement and display of the wheel in play with respect to those not currently in play

(See Figure 4). It would have been obvious to one of ordinary skill in the art at the time

of invention to have incorporated the enlarged displaying of a selected wheel as taught

by Baerlocher et al. in the invention of O'Halloran in order to suit the theme of the bonus

game being played or adapt an existing bonus game to a machine with a wheel theme.

Regarding claim 20, and in addition to the above stated, Baerlocher et al.

discloses that the return of the underlying game is increased by the secondary game,

stated as, "If the wheel lands on neither the bonus nor bankrupt indicium, the credit

value 212 is preferably incremented by the amount associated with the indicium 412

times the number of coins played" (column 8, lines 20-25). Thus, if the player obtains a

winning outcome in the bonus round the credits are awarded to the underlying game

credit score and play of the underlying game continues.

Regarding claim 21, and in addition to the above stated, O'Halloran teaches the

claim limitation that "none of said prize sets include a losing outcome which results in

the loss of any prize awarded in the underlying game", in that the selection of a non-

joker card returns the player to the underlying game but does not adversely affect the

player score or credits earned by said player in the underlying game. Further, Baelocher

et al. teach the limitation that "at least one of said prize sets includes at least two

winning outcomes", wherein each wheel, i.e. prize set, contains multiple winning

outcomes (see figures 4 and 5).

Regarding claim 22 and 23 and in addition to the above stated, Baerlocher et al.

discloses the claim limitation that at least two of the wheels, or prize sets, have different

volatilities, wherein "the second wheel is similar to the first wheel but preferably does

not contain a bankrupt indicium" (column 8, lines 2-30). Because the second wheel has

fewer bankrupt indicium than the first wheel, it contains fewer non-winning outcomes

and is therefore less volatile than the first wheel, thus meeting the claim limitation of at

least two prize sets containing different volatilities.

2.   Claims 10, 11, 13, and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over O'Halloran (US 6,450,883) in view of Baerlocher et al. (US

5,788,573) further in view of DeMar et al. (US 6,315,660).

The combination as taught by O'Halloran/Baerlocher et al taught above is silent

regarding the use of dice as the three dimensional object and the use of a board game

representations as so claimed. DeMar et al discloses a bonus game for a spinning reel

game of chance containing a bonus round that incorporates a board game feature

(Element 62) wherein a random role of dice (Element 64) or simulation thereof (Element

43) determine the distance traveled on the board and the prize outcome (See Figures

1,6,8,13,16B, and 24). Further as presented in at least claim 11 the prizes defining the

faces of the dice corresponds to the number shown on the dice of DeMar and

corresponding prize associated with the resultant board position of the player

piece/game token combined with the display of the prize values that define segments of

a wheel as presented in Baerlocher et al and shown above.

It would have been obvious to one of ordinary skill in the art at the time of

invention to incorporate the use of dice as the three dimensional object in game

representation in the game as taught by O'Halloran/Baechlocher, in light of the

teachings of DeMar et al, in order to extend the period of player anticipation through

giving the impression that they are watching the determination of the game result in a

similar fashion to the spinning of the reels of a traditional slot machine.

Response to Arguments

Applicant's arguments, see page 11 paragraphs 2, 3, and 4, filed January 12 2006, with respect to the 35 U.S.C. 112 rejection of claim 20 have been fully considered and are persuasive. The rejection of June 1 2005 has been withdrawn.

Applicant's arguments filed January 12 2006 have been fully considered but they are not persuasive.

Regarding the argument that the cited art fails to teach or suggest the limitation in claims 1, 14 and 17 that "each prize set has the same number of potential outcomes from which prize sets a prize is to be drawn and awarded to the player", the wheels of fortune, or prize sets, taught by Baerlocher et al. may be viewed as individual prize sets and not as a single prize set as argued by the applicant, as sequential winnings are not required in order for a player to obtain a prize. As disclosed in the specification, a player may be awarded a prize upon spinning the first wheel, irrespective of a second or third wheel spin, stated as "If the wheel lands on neither the bonus nor bankrupt indicium, the credit value 212 is preferably incremented by the amount associated with the indicium 412 times the number of coins played" (column 8, lines 20-25). Thus, the prize set contained in wheel one may be awarded independent of the prize sets contained by wheels two and three, and therefore the prize sets may be seen as individual prize sets.

Regarding the argument that in the event that the examiner chooses to view the wheels of fortune disclosed by Baerlocher et al. as individual prize sets then the three prize sets will have different returns to the player, the examiner argues that the

combination of references, O'Halloran in view of Baerlocher et al., does in fact meet this limitation. The rows of cards, i.e. prize sets disclosed by O'Halloran contain a different number of possible outcomes, however the total theoretical winning outcome is the same between individual rows. For example, in prize set 1, if the player selects a non-winning outcome (i.e. any non-joker card) their bonus winnings equal zero and they return to the base game, however the player has a 1 in 2 chance of winning two times the amount of their base game winnings. Thus, the total theoretical amount won in first prize set of the bonus game = $((1/2) * 2 *$ base game winnings$) + ((1/2) * 0) =$ base game winnings. Similarly, in prize set 2, the player has a 1 in 3 chance of winning three times the amount of their base game winnings, or $((1/3) * 3 *$ base game winnings$) + ((2/3) * 0) =$ base game winnings. In the same manner, in prize set 3 the player has a 1 in 4 chance of winning four times the amount of their base game winnings, or $((1/4) * 4 *$ base game winnings$) + ((3/4) * 0) =$ base game winnings. From this it is shown that the total theoretical outcome for each prize set is equal to the base game winnings and is therefore the same for each prize set.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to

combine the references exists in that they both intend to enhance player excitement by adding a bonus game feature that increases credit winning possibilities.

In response to applicant's argument that the combination of references O'Halloran in view of Baerlocher et al. does not teach the claim limitation that if a non-winning outcome occurs in the feature game, this does not adversely affect the winnings earned by the player in the underlying game, is not persuasive. The examiner argues that the "Bankrupt" feature disclosed by Baerlocher et al. does not result in a loss of the stake wagered on the base game but merely returns the player to the beginning of the game, as stated in column 8, lines 7-10. As shown in Figure 1, obtaining a "Bankrupt" indicium returns the player to the main screen where they may continue to play the base game, however Baerlocher does not disclose the loss of all winnings gained in said base game.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
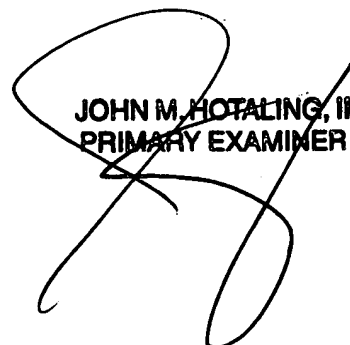
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mjt

JOHN M. HOTALING, II
PRIMARY EXAMINER